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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,915	09/18/2003	Rajendra Mehta	STD 1184 PA/41213.541	6466

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,915

Applicant(s)

MEHTA ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 50-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 and 60-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Election

1. Applicant's election of (Group I) Claims 1-49 in the reply filed on January 26, 2006, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The requirement is deemed proper and is therefore made **FINAL**.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 6-12, 18-22, 30-32 and 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,250,492).

Dotson discloses a security document (column 1, line 8) having a substrate coated on at least a portion of one of its major surfaces with an image that becomes visible upon the application of pressure or a solvent (column 4, lines 9-25 and column 7, lines 58-66) where some images are abrasion sensitive (column 3, lines 14-20). Any solvent which is capable of dissolving the color former or color developer can be used in the invention (column 4, lines 38-40) where the spot coating comprising flexographic

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printing (column 5, lines 20-25). Dotson discloses the invention comprises a first and second coating where the first coating has a pressure ruptural component and the second coating has a solvent sensitive material (column 6, line 58 through column 7, line 5). The coating area has a covert image with a warning phrase such as VOID which results when the area has been subjected to attempted alteration (column 16, lines 44-50 and Figure 11). Dotson does not show that the flexographic ink has a property percentage as in instant claim 8. However, such percentages are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the property percentages, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. percentage) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they directly affect the opacity of the document. It would have been obvious to one of ordinary skill in the art to make the security document with the limitations of the flexographic ink percentage properties since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

Claim Rejections – 35 USC § 103(a)

4. Claims 16-17 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,250,492) in view of Taylor et al (U.S. 6,062,604).

Dotson is relied upon for claim 1. Dotson does not disclose folding the document. Taylor teaches a security document comprising optically variable ink (column 1, lines 9-21) formed from a substrate having a coating on one or both sides, where the sheet is flexible and can be folded about a center line, which bring both sides of the folded article together (column 2, lines 22-46). Dotson and Taylor are both directed to security documents. It would have been obvious to one of ordinary skill in the art to have folded the security document, as taught in Taylor, in the security document of Dotson so the second portion of the security document can be inspected or verified by viewing both the first and second portions together (column 2, lines 54-64).

Claim Rejections – 35 USC § 103(a)

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,250,492) in view of Berson (U.S. 5,932,870).

Dotson is relied upon for claim 1. Dotson does not disclose a bar code. Berson teaches a security document in the form of a drivers license having a bar code for abrasion resistance. Dotson and Berson are both directed to security documents. It would have been obvious to one of ordinary skill in the art to have included a bar code,

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as taught in Berson, in the security document of Dotson to improve the security for the documents (column 2, lines 20-27).

Claim Rejections – 35 USC § 103(a)

6. Claim 13-15 and 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,250,492) in view of Halbrook, Jr. et al. (U.S. 5,883,043).

Dotson is relied upon for claim 1, as above. Dotson does not explicitly disclose optically variable ink such as thermochromic ink. Halbrook, Jr. teaches a security document (column 1, lines 5-10) having optically variable pigments and dyes such as thermochromic (column 3, lines 1-5). Dotson and Halbrook, Jr. are both directed to security documents. It would have been obvious to one of ordinary skill in the art to have included thermochromic ink, as taught in Halbrook, Jr., in the security document of Dotson to improve the security for the document.

Claim Rejections – 35 USC § 103(a)

7. Claims 4-5, 24-29, 33-46 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,250,492) in view of Lu (U.S. 5,591,527).

Dotson is relied upon for claim 1, as above. Dotson does not disclose the article is a drivers license. Lu teaches security articles comprising an image or design (column 1, lines 50-55) having a separation layers (column 2, lines 10-25) where the substrate may be made of paper and is a drivers license (column 3, lines 1-5). Lu further teaches the article has a layer to protect the substrate (column 5, lines 17-22) having a laminate

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comprising two or more layers (column 12, lines 55-60) which are tear resistant. The article can be coated on the back side of the article (column 16, lines 5-11). Dotson and Lu are both directed to security documents. It would have been obvious to one of ordinary skill in the art for the security document to be drivers license, as taught in Lu having the added security features to protect and identify the consumers using the security cards.

Response to Arguments

8. Rejection made under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579) is withdrawn due to Applicant's amendments to the claims.

Rejection made under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579) in view of Taylor et al (U.S. 6,062,604) is withdrawn due to Applicant's amendments to the claims. Rejection made under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579) in view of Berson (U.S. 5,932,870) is withdrawn due to Applicant's amendments to the claims. Rejection made under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579) in view of Halbrook, Jr. et al. (U.S. 5,883,043) is withdrawn due to Applicant's amendments to the claims. Rejection made under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579) in view of Lu (U.S. 5,591,527) is withdrawn due to Applicant's amendments to the claims.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


L. Ferguson
Patent Examiner
AU 1774


RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 4/17/04